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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,769	09/22/1999	ERIK HELMERHORST	28594/35007A	3787

7590 06/12/2002

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EXAMINER

ROBINSON, HOPE A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 06/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/400,769

Applicant(s)
Helmerhorst et al.

Examiner
Hope Robinson

Art Unit
1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 15, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 4 6) ☐ Other: _____

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DETAILED ACTION

1. Applicant's election without of a specific compound (claim 10(viii)) to be examined on the merits in Paper No 13 is acknowledged. In addition, applicant's election with traverse of species to be searched in claims 5, 6, 10 and 15 in Paper No. 20 is acknowledged. of Group II (claims 5-19) in Paper No. 10 is acknowledged.
2. Applicant's election of species to be searched in claims 5, 6, 10 and 15 in Paper No. 20 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Disposition

3. Claims 1-19 are pending in the present application and under examination as Paper No. 11 rejoined Groups I and II.

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Information Disclosure Statement

4. The information disclosure statement filed on 12/27/99 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP 609 because the items listed on pages 1-9 of the information disclosure statement are missing from the application.

Correction is required.

Claim Rejections - 35 U.S.C. § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Note that the claim is directed to methods with no method steps. As the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. Claim 16 recites "comparing" and "selecting" which do not appear to be positive method steps for a "method for identifying a non-peptidyl compound. Without setting forth any steps involved in the process/method, results in an improper definition of a process and is not a proper process claim under 35 U.S.C. 101. See for

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example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and the dependent claims hereto are indefinite because the claim recites the term "biological modulator" and it is unclear if applicant intends modulate to mean increase or decrease (see also claim 11). Note that only one of these terms should be recited in the claim. The claim is also indefinite as the word "peptidyl" is misspelled as "petidyl".

Claim 5 is indefinite for the recitation of "so as mimic" as it appears the transitional phrase "to" is missing.

Regarding claim 6, the phrases "for example but not limited to", "examples include" and "including but not limited to" renders the claim indefinite because it is unclear whether the

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limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d), see also the dependent claims hereto (see also claim 11).

Claim 11 is indefinite for the recitation of "and/or" because it is unclear if the slash mark means "and" or "or". Deletion of the slash mark and recitation of just one of the terms is suggested (the dependent claims hereto are also included in this rejection).

Claims 18 and 19 are indefinite because the claims do not further limit the claims from which they depend.

Art of Record

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ganong (1989 Review of Medical Physiology, 1989). Ganong teach the insulin structure.

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Conclusion

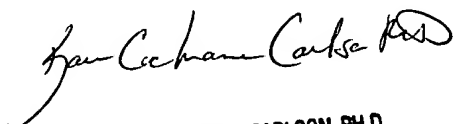
8. No claims are allowable.


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hope A. Robinson whose telephone number is (703)308-6231. The Examiner can normally be reached on Monday - Friday from 9:00 A.M. to 5:30 P.M. (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Christopher S.F. Low, can be reached at (703)308-2932.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703)308-0196.

Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-2742. Please affix the Examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).


KAREN COCHRANE CARLSON, PH.D
PRIMARY EXAMINER

Hope A. Robinson, MS 
Patent Examiner